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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Robert Seseek

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01/11/2006

HEWLETT-PACKARD COMPANY

Intellectual Property Administration

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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/887,833	SESEK, ROBERT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gregory J. Vaughn	2178	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-15,18,19 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-15,18,19 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Action Background***

1. This action is responsive to the applicant's response and submission of a Declaration of Prior Invention Under CFR 1.131, filed on 10/24/2005.
2. Applicant has not amended the claims with this response.
3. Claims 1, 3-7, 9-15, 18, 19 and 23-25 are pending in the case, claims 1, 7, 12, 15, 19 and 23 are independent claims.
4. Claims 1, 3-7, 9-15, 18, 19 and 23-25 remain rejected under 35 USC 102 or 103, as described below

### ***Response to Declaration Under 37 C.F.R. 1.131***

5. The applicant's declaration filed 10/24/2005 under 37 C.F.R. 1.131 has been considered but is ineffective to overcome the effective filing date of the Rhoads or Besprosvan references.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Rhoads or Besprosvan references, up to the date of constructive reduction to practice (i.e. filing date of application serial number 09/887,833).

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The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Rhoads or Besprosvan references to either a constructive reduction to practice or an actual reduction to practice.

The declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964). See MPEP 715.07.

In general proof of actual reduction to practice requires a showing that the apparatus or method actually existed and worked for its intended purpose. This proof is demonstrated with satisfactory evidence of facts supporting priority of invention, said proof usually in the form of exhibits. Examples of support include sketches, blueprints, photographs, reproductions of notebook entries, accompanying models, supporting statements by witnesses, interference testimony, and or prior submissions to the USPTO of Disclosure documents.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). See MPEP 715.07(b).

Also, please note that an applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). See MPEP 2138.06.

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). See MPEP 2138.06.

Also, please note the diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. See MPEP 2138.06 for the nature of the showing that the attorney must make.

In view of the patent examination rules and procedures described above, the presented combination of evidence within the declarations and exhibits A-I are insufficient proof that applicant's invention was diligently reduced to

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practice before the filing date of the Rhoads or Besprosvan references, and prior to the filing date of applicant's invention.

Specifically, Exhibit A of the declaration is an Inventive Disclosure made by the inventor and dated 8/4/2000. On page 1 of said inventive disclosure, in the middle of the page, the inventor declared that the invention was neither built nor tested (shown as the question "*Was the invention built or tested? If so, the date.*" with the inventor's response being "*No*"). The inventor's response indicates that the invention did not exist, and therefore could not have worked for its intended purpose. Nothing in the subsequent Exhibits B-I remedy the deficiency of Exhibit A. Accordingly, said declaration is ineffective to overcome the effective filing date of the Rhoads or Besprosvan references for at least this reason.

Furthermore, Exhibits B-I are insufficient to establish diligence from a date prior to the date of reduction to practice of the Rhoads or Besprosvan references to either a constructive reduction to practice or an actual reduction to practice. While Exhibit A (the invention disclosure, dated 8/4/2000) appears to establish conception of the invention, Exhibits B-I describe events related to the time line for the invention of conception through application filing (6/21/2001), but fail to account for the entire period during which diligence is required with either affirmative acts or acceptable excuses.

Exhibit B is a declaration by the applicant's representative and includes attachments 1-3. Attachment 1 is an Engagement Agreement for the attorney to prepare a US patent application, dated 10/17/2000. No explanation is given

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for the two and a half month period between the conception and the Engagement Agreement.

Exhibits B-I support events related to the application preparation from 10/17/2000 through 5/24/2001. Exhibit I is a letter from the attorney, dated 5/24/2001, indicating that the patent application was ready for submission to the USPTO. Exhibit B states: "*Preparation of the present patent application also occurred generally during the same time period through March 2001 to June 2001*". However Exhibit I indicates that the patent application was ready on 5/21/2001. No explanation is given for the 4 week period between the completed application and the filing thereof.

Applicant has not carried the burden of showing facts or data applicant is relying on to show reduction to practice or diligence of the invention prior to the Rhoads or Besprosvan references.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."*

7. Claims 1, 3-7, 9, 10, 12, 13, 15, 18, 19, and 23-25 remain rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads US Patent publication 2002/0142765, filed 3/30/2001, published 10/3/2002.

8. **Regarding independent claim 1**, Roads discloses sending an electronic document from an electronic document sender to an electronic document receiver having an electronic address. Rhoads recites: *"Although one embodiment comprises a network appliance, any network device can be used, e.g., a server, a printer, a copier or a facsimile machine"* (page 2, paragraph 25). A facsimile machine is well know in the art as an electronic document sending device that sends an electronic document to an electronic document receiver (i.e. another facsimile machine) having an electronic address.



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Rhoads discloses electronically obtaining an electronic address of an electronic document receiver, via wireless communication, from an address book stored in a mobile computing device. Rhoads recites: "*FIG. 2b is a block diagram of one embodiment of a network appliance (e.g., a rack-mounted appliance) capable of receiving IR signals containing configuration information (e.g., an IP address) from a wireless device*" (page 2, paragraph 18).

9. **Regarding dependent claim 3**, Rhoads discloses the electronic document sender as a digital sender. Rhoads recites: "*Although one embodiment comprises a network appliance, any network device can be used, e.g., a server, a printer, a copier or a facsimile machine*" (page 2, paragraph 25). A facsimile machine is well known in the art as a digital sender.

10. **Regarding dependent claim 4**, Rhoads discloses the mobile computing device as a personal digital assistant. Rhoads recites: "*Wireless device 102 may be any device capable of generating, encoding and transmitting IR signals. In one embodiment, wireless device 102 is a personal digital assistant (PDA)*" (page 2, paragraph 26).

11. **Regarding dependent claim 5**, Rhoads discloses an electronic document receiver as a facsimile machine. Rhoads recites: "*Although one embodiment comprises a network appliance, any network device can be used, e.g., a*

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*server, a printer, a copier or a facsimile machine"* (page 2, paragraph 25). A

facsimile machine is well known in the art as electronic document receiver.

12. **Regarding dependent claim 6**, Rhoads discloses the electronic address as a network address. Rhoads recites: *"FIG. 2b is a block diagram of one embodiment of a network appliance (e.g., a rack-mounted appliance) capable of receiving IR signals containing configuration information (e.g., an IP address) from a wireless device"* (page 2, paragraph 18).
13. **Regarding independent claim 7**, the claim contains substantially the same subject matter as claim 1, and is rejected using the same rationale.
14. **Regarding dependent claim 9**, Rhoads discloses a facsimile machine (as described above), which is well known in the art to image a paper document.
15. **Regarding dependent claim 10**, Rhoads discloses storing the electronic address within the electronic document sender. Rhoads recites: *"Finally, the configuration information is stored in the appliance's memory"* (page 1, paragraph 16).
16. **Regarding independent claim 12**, the claim is directed toward a device for the method of claims 1 and 9 combined, and is rejected using the same rationale.

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17. **Regarding dependent claim 13**, the claim is directed toward a device for the method of claim 5, and is rejected using the same rationale.
18. **Regarding independent claim 15**, the claim is directed toward a system for the method of claim 1, and is rejected using the same rationale.
19. **Regarding dependent claim 18**, Rhoads discloses maintaining an address book of addresses. Rhoads recites: *"A PDA is a small mobile hand-held device that provides computing and information storage and retrieval capabilities for personal or business use. Most PDA's which are often used to provide immediate access to appointment and address book information"* (page 2, paragraph 26).
20. **Regarding independent claim 19**, the claim is directed toward a device for the device of claims 12 and 18 combined, and is rejected using the same rationale.
21. **Regarding independent claim 23**, the claim is directed toward computer readable medium for the method of claim 7, and is rejected using the same rationale.
22. **Regarding dependent claim 24**, the claim is directed toward computer readable medium for the method of claim 1, and is rejected using the same rationale.

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23. **Regarding dependent claim 25**, the claim is directed toward computer readable medium for the method of claim 9, and is rejected using the same rationale.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 902 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

25. Claim 11 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads in view of Hattori et al. US Patent 6,512,599, filed 1/19/1999, patented 1/28/2003.

26. **Regarding dependent claim 11**, Rhoads discloses sending documents with addresses imported from mobile computing devices as described above. Murphy fails to disclose erasing transmission data after transmission of the document. Hattori teaches erasing transmission data after transmission of the document. Hattori recites: *"During the fax to print and send function, the fax transmission data is deleted after the fax transmission data is printed and transmitted"* (column 40, lines 9-11)

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine Rhoads' document sending method with the transmission data eraser process of Hattori because: *"the fax transmission data is deleted after it has been transmitted, the memory region of the RAM 63 or 64, which stores the fax transmission data, can be effectively used"* (Hattori, column 40, lines 12-15)

27. Claim 14 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads in view of Besprosvan. US Publication 2002/0124057, filed 3/5/2001, published 9/5/2002.

28. **Regarding dependent claim 14**, Rhoads discloses a document-sending device with addresses imported from mobile computing devices as described above. Murphy fails to disclose the use of a distribution list. Besprosvan teaches the use of a distribution list. Besprosvan recites: *"The sixth operational feature relating to Web browser access respecting the address book is "group lists." The user is able to create group distribution lists. Group lists allow for message distribution to selected fax and/or e-mail entries in the group"* (page 6, paragraph 84).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine Rhoads' document sending with the distribution list as taught by Besprosvan, in order to provide *"a unified communications system to integrate telephone, facsimile, and e-mail communications, as well as communications through document dissemination*

*and video or other digital communication technique"* (Besprosvan, page 1, paragraph 1).

***Response to Arguments***

29. Applicant's arguments filed 10/24/2005 have been fully considered but they are not persuasive.

30. Applicant's arguments are substantially directed toward disqualifying the Rhoads or Besprosvan references in view of applicant's Declaration of Prior Invention (filed 10/24/2005). The examiner has considered applicant's Declaration of Prior Invention, but has determined the Declaration is ineffective to overcome the effective filing date of the Rhoads or Besprosvan references, as fully described above.

***Conclusion***

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

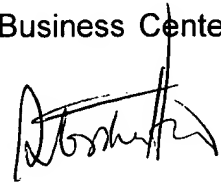
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**

Gregory J. Vaughn  
January 6, 2006